

## REMARKS

### Status of the Claims

Claims 94-102, 106, 107, and 111-123 are currently pending. Claims 1-93, 103-105, and 108-110 have been canceled without prejudice or disclaimer of the subject matter claimed therein. New claims 112-123 have been added.

Claims 94-97 and 111 have been withdrawn from consideration as being drawn to a separate species. It is Applicants' understanding that the Examiner intends to begin by searching the elected species and will continue searching until art is found or until a generic claim is found allowable. Applicants also point out that when a generic claim is found to be allowable, the withdrawn claims which depend from or include the limitations of the allowed claim must be rejoined and fully examined for patentability (see MPEP 809).

### Amendment of the Claims

Claims 98-102, 106, and 107 have been amended, and new claims 112-123 have been added. Support for the amendments and the new claims can be found throughout the specification as originally filed. Representative support is summarized below.

Representative support for the amendments to claims 98-102, 106, and 107 can be found in original claims 47, 60, 81, 103, and 108.

Representative support for new claims 112-123 can be found on page 8, lines 5-10, page 13, line 19 to page 15, line 3, and page 17, line 5.

The amendments to claims 98-102, 106, and 107 and the addition of new claims 112-123 do not introduce prohibited new matter.

### Rejoinder

New claims 112-123 are directed to methods of using the device of claims 98-102, 106, and 107.

Applicant respectfully points out that MPEP 821.04(b) requires that once a product claim is found allowable, withdrawn method claims which depend from or otherwise include all the limitations of the allowable product claim must be rejoined. Thus, once a claim directed to the device (claims 98-102, 106, and 107) is found allowable, withdrawn method claims (claims 112-

123) which depend from or otherwise include all the limitations of the allowed claim should be rejoined.

Rejection under 35 U.S.C. § 112, Second Paragraph

Claims 33-46, 78-86, and 111 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 33-46 and 78-86 have been canceled without prejudice or disclaimer of the subject matter claimed therein. Claim 111 has been withdrawn from consideration as being dependent upon withdrawn claims.

Rejection under 35 U.S.C. § 102(e)

Claims 98, 99, 102, 105, 109, and 110 are rejected under 35 U.S.C. 102(e) as being anticipated by Klimack *et al.* (Klimack).

Claims 105, 109, and 110 have been canceled without prejudice or disclaimer of the subject matter claimed wherein.

Applicants respectfully point out that the Office Action has not included claims 103 and 108, drawn to pneumatically operated first and second actuation units, under this rejection. Claims 103 and 108 have been canceled and the features of these claims 103 and 108 have been incorporated into claim 98. Accordingly, claim 98 and its dependent claims 99 and 102, as they stand, are not anticipated by Klimack. Moreover, Klimack does not disclose or suggest the claimed substrate cutting device because Klimack only discloses a cutting device comprising a rack and worm gear assembly to drive the cutter head. Accordingly, Applicants respectfully request withdrawal of the rejection.

Rejections under 35 U.S.C. § 103(a)

A. Claims 50-63 and 78-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colman in view of Asakura *et al.* and further in view of Yamazaki *et al.*

Without acquiescing to the propriety of the rejection and in the interest of expediting prosecution of this application, claims 50-63 and 78-86 have been canceled without prejudice or disclaimer of the subject matter claimed therein.

B. Claims 103, 104, 106, 107, 108, and 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klimack *et al.* (Klimack).

As mentioned above, claims 103, 104, 108, and 110 have been canceled without prejudice or disclaimer of the subject matter claimed therein, and the features of claims 103 and 108 have been incorporated into claim 98. Claims 106 and 107 are dependent upon claim 98.

As discussed above, Klimack does not disclose or suggest the claimed invention. Applicants respectfully point out that Klimack is directed to an apparatus for cutting steel pipes. One would not expect Klimack to use a pneumatically operated apparatus to cut a steel pipe because a pneumatically operated apparatus, which utilizes air pressure to drive the perforation and cutting mechanisms, would not provide sufficient force to cut hard materials such as a steel pipe. Moreover, in contrast to the claimed invention, the apparatus of Klimack is designed to cut grooves or perforation into steel pipes. Accordingly, there is no reason to modify the teachings of Klimack so as to make the claimed invention with reasonable expectation of success. Therefore, Klimack does not render the claimed invention obvious.

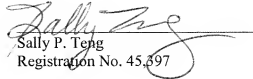
#### Conclusion

The foregoing amendments and remarks are being made to place the application in condition for allowance. Applicants respectfully request entry of the amendments, reconsideration, and the timely allowance of the pending claims. A favorable action is awaited. Should an interview be helpful to further prosecution of this application, the Examiner is invited to telephone the undersigned.

If there are any additional fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,  
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